

**REMARKS**

Claims 1-4, 7, and 9-21 are pending in this application.

Applicants thank the Examiner for taking the time to discuss the pending application with the undersigned during a telephone interview held on June 21, 2005. During the interview, the pending claims and the Saylor et al. (U.S. Patent No. 5,487,139) and Tamano et al. (U.S. Patent No. 6,032,157) references were discussed.

In the Office Action,<sup>1</sup> the Examiner rejected claims 1-4 and 7, and 9-22 under 35 U.S.C. § 103(a) as unpatentable over Saylor et al. (U.S. Patent No. 5,487,139) in view of Bell (U.S. Patent No. 5,422,989) and in further view of Moore et al. (U.S. Patent No. 6,377,210). Applicants respectfully traverse the rejection for at least the following reasons.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8<sup>th</sup> ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8<sup>th</sup> ed.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001).

Claim 1 recites a method for manipulating a map using a data processing system including, among other steps, "converting the first map coordinates to corresponding geographic coordinates using a georeferencing function of the first map; converting the geographic coordinates to corresponding second map coordinates using a georeferencing function of the second map" and "determining a geographic region on the second map corresponding to the first region using the second map coordinates." Saylor, Bell, and Moore, whether taken alone or in combination, do not disclose or suggest all of these steps of claim 1.

In the Office Action, the Examiner admits that both Saylor and Bell do not disclose the use of a georeferencing function. See, for example, page 16. However, the Examiner alleges Moore compensates for this admitted deficiency of Saylor and Bell. In particular, the Examiner alleges that Moore discloses "vehicle geographic coordinates are converted to the pixel coordinates" and "the geographic coordinates are calculated when the user points to the display location on the map image." See Office Action, page 16. Applicants disagree with the Examiner's characterization of Moore.

Moore discloses that a "first "Geo-Code" operation identifies the street address and city/town designation of a particular vehicle location, building, or other landmark which has been geographically referenced on a particular map." See col. 12, lines 6-9. A "location of an entity, such as a street address ... [is determined] in a geographic coordinate system using the process described above to place the entity in the correct pixel location on the map display." See col. 12, lines 20-24. The process disclosed by

Moore uses “underlying map data 40 [that] can come from any source.... Static maps from any source are prepared in advance using a geographic information system, such as Mapinfo and Intergraph's Microstation, scanned images or manually hand plotted drawings that are scanned to create digital images. Certain coordinate references are registered by registering certain specific pixels in a map display with true earth coordinate projections, for example, longitude and latitude. This enables the vehicle locations as generated from the GPS data received by the datacenter 20 from each mobile equipment 11 to be properly placed on a particular map display, such as the map display 44 shown in FIG. 10.” See col. 9, lines 30-40. As disclosed, coordinate references are registered by registering certain specific pixels in a map display with true earth coordinate projections, such as longitude and latitude. Accordingly, since Moore relies upon predetermined correspondences between pixels and longitude and latitude, Moore does not disclose or suggest at least the claimed steps of “converting the first map coordinates to corresponding geographic coordinates *using a georeferencing function of the first map*” and “converting the geographic coordinates to corresponding second map coordinates *using a georeferencing function of the second map*,” as recited in claim 1 (emphasis added).

Accordingly, for at least the above reasons, Saylor, Bell, and Moore, whether taken alone or in combination, do not teach or suggest each and every element of claim 1. Applicants therefore respectfully request the Examiner to allow claim 1.

Independent claims 15 and 19 recite similar limitations as claim 1. Thus, for at least the reasons as discussed above, Saylor, Bell, and Moore, taken alone or in

combination, also fail to disclose or suggest claims 15 and 19. Accordingly, Applicants respectfully request the Examiner to allow claims 15 and 19 as well.

Claims 2-4, 7, 9-14, and 21 depend from claim 1. Claims 16-18 depend from claim 15, and claim 20 depends from claim 19. Since Saylor Bell, and Moore, taken alone or in combination, fail to disclose or suggest every element of independent claims 1, 15, and 19, these references also fail to disclose or suggest every element of the claims that depend therefrom. Accordingly, Applicants also respectfully request the Examiner to also allow claims 2-4, 7, 9-14, 16-18, 20, and 21.

### **CONCLUSION**

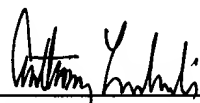
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By   
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